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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |  |  |
|---|-------------|----------------------|---------------------|------------------|--|--|
| 10/598,047  | 08/16/2006  | Ferdinand Kockerling | 72328               | 9515             |  |  |
| 23872   | 7590        | 08/11/2009           | EXAMINER            |                  |  |  |
| MCGLEW & TUTTLE, PC<br>P.O. BOX 9227<br>SCARBOROUGH STATION<br>SCARBOROUGH, NY 10510-9227 |             |                      |                     | MASHACK, MARK F  |  |  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |  |  |
| 3773  |             |                      |                     |                  |  |  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |  |  |
| 08/11/2009  |             | PAPER                |                     |                  |  |  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/598,047             | KOCKERLING ET AL.   |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | MARK MASHACK           | 3773                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 May 2009.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 and 3-21 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1 and 3-21 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

    1. Certified copies of the priority documents have been received.

    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

This office action is in response to a communication dated 5/22/2009. Claims 1 and 3-21 are pending.

### ***Response to Arguments***

1. Applicant's arguments filed 5/22/2009 have been fully considered but they are not persuasive. Applicant argues that "**Debbas** fails to teach and fails to suggest the combination of a sewing bridge that is integrally connected to mesh material of a base sheet as claimed". Examiner disagrees. **Debba** explicitly states "of course, in the present invention, the flap may be formed integrally in the mesh material" (Column 7, Lines 10-14).

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1, 3, 5, 7, 10-13, 17, 20-21** rejected under 35 U.S.C. 102(b) as being anticipated by **Debbas (US 5,716,409)**.

**Debbas** discloses a hernia mesh fabric comprising: a base sheet **10, 20**; a passage **14, 24**; an insertion slit **12, 22**; and a rectangular sewing bridge **16, 26** wherein the sewing bridge is capable of being stitched to the base sheet on both sides (Column 4, Lines 23-27 and Column 4, Lines 50-59). Stitching the base sheet on both sides

comprises a double stitch seam with two seams displaced inwards at a distance. **Claim 2 and Claim 7** are regarded as product-by-process and the mesh and bridge can be cut to size in one piece by the aid of a laser cutting beam. The mesh preferably comprises polypropylene (Column 1, Lines 19-24). The bridge can be integrally attached adjacent to the mouth of the insertion slit (Column 7, Lines 10-14).

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claim 4, 14** is rejected under 35 U.S.C. 102(b) as anticipated by **Debbas** or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Debbas** in view of **Bardeau (FR 2 744 906)**.

The insertion slit **12, 22** of **Debbas** can be divided into two equal sides and the sewing bridge **16, 26** of **Debbas** covers both sides of the insertion slit symmetrically. If

that is not convincing, **Bardeau** teaches of having the bridge **3** cover equal amounts of the base sheet **1** on both sides of the slit **5**. Given the teachings of **Bardeau**, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of **Debbas** by having the sewing bridge cover equal amounts of base sheet on both sides of the slit. Doing so would create favorable stress concentrations.

6. **Claim 6, 15-16** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Debbas** in view of **Therin et al. ("Therin" US 2002/0013590)**.

**Debbas** discloses all of the claimed limitations as stated above except for the base sheet and/or bridge tongue having rounded corners. However, **Therin** teaches of a hernia mesh pad comprising round corners (FIG 1-2). Given the teachings of **Therin**, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the hernia mesh of **Debbas** with rounded corners. Doing so would ensure proper coverage and placement of the mesh pad.

7. **Claims 8-9, 18-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Debbas** in view of **Wilberg (DE 198 32 634)**.

**Debbas** discloses all of the claimed limitations except for the titanium coating. However, **Wilberg** teaches of a multi-layer hernia implant comprising a titanium layer. (Column 4, Lines 17-28). All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded

predictable results to one of ordinary skill in the art at the time of the invention. Given the teachings of **Wilberg**, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the hernia implant of **Debbas** with a titanium coating. Doing so would increase the adhesion factor between the sheet and the bridge (Column 4, Lines 17-28). **Regarding Claim 9 and 19**, a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK MASHACK whose telephone number is

(571)270-3861. The examiner can normally be reached on Monday-Thursday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Mashack/  
Examiner, Art Unit 3773

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773

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